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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/652,709	08/31/2000	Oscar Lee Avant	08049.009	3489

22852 7590 12/30/2002

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EXAMINER

SCHLAK, DANIEL K

ART UNIT	PAPER NUMBER
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3653

DATE MAILED: 12/30/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

8K

Office Action Summary

Application No.

09/652,709

Applicant(s)

AVANT ET AL.

Examiner

Daniel K Schlak

Art Unit

3653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 October 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-158 is/are pending in the application.
- 4a) Of the above claim(s) 105-158 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-104 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 8/30/02 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-104 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The independent method and apparatus claims all recite conditional method steps and constructional elements, respectively. A further explanation of this is to be found in the response to arguments, later in the action, and also in the prior Office action.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-104 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by US 5,667,078.

Claims 1-104 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by admitted prior art.

Claims 1-104 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by US 5,249,687.

Please note that the Examiner interpreted all of the claims as only comprising a single step/element in/by which mail is sorted using a code on the front. Nothing after the conditional recitations has been considered, all subsequent recitations having been granted no patentable weight in light of their conditional existence in application. More particularly, in the mine field that is all the "if" recitations of the claims, the Examiner has selected *one "if" and one "component" or "step" corresponding thereto*.

Both the references and the background summary of the instant application describe a method/device in which mail is sorted based upon a code residing on the front of the mailpiece.

The burden is now upon the applicant to state which components are not taught by each reference, because the Examiner stands by the anticipations and their respective clarity.

Response to Arguments

Applicant's arguments filed 10/11/02 have been fully considered but they are not persuasive.

With respect to the apparatus claims, the Examiner maintains that they are not constant through time, depending upon the mailpiece being fed to the apparatus.

Art Unit: 3653

It was clear from the rejections under 35 U.S.C. 112, 2nd Paragraph in the first Office action that the Examiner was rejecting all of the conditional recitations in the claims.

Applicant alleges that the dependence of apparatus steps is not conditional upon the mailpiece status. Applicant particularly selects claim 9 for discussion. The Examiner shall follow suit. Applicant is directed to lines 9-11 of that claim (9). Therein is recited "wherein, if the mailpiece does not have the code on the front or on the back of the mailpiece, the identification code system sorting component further includes:"

The claim then goes on to recite three "components" which, *in no interpretation whatsoever*, can be considered to exist when the mailpiece *does indeed* have the code on one of the front and back.

Citing a further example, the Examiner directs applicant to claim 43. Lines 7-9 of claim 43 recite "wherein, if the mailpiece does not have the code on the front or on the back of the mailpiece, the sorting means includes:"

This recitation is similar to that cited from claim 9, and is followed by a list of "means for" marking, taking an image, process, etc. whose existences are hinged upon the code failing to exist on a mailpiece. In other words, the existence of certain parts of the claim is established by the failure of something else to exist. Does applicant consider this definitive claim language? How can the Examiner search or apply art to apparatus claims with elements whose existences are hinged upon the lack of existence of some spot of ink?

In referring to the method claims; can applicant state, for the record, that three distinct method steps do not coexist in claim 19? The Examiner understands that the method *could* act in compliance with any of the three. However, in the event that a mailpiece is fed which has a code on the front, the method of claim 19 does no more than sorting the mailpiece using the code on the front. This method has been in use for well over a decade in post offices around the world. Thus, the anticipation of the rejections under 35 U.S.C. 102.

Continuing to lines 7-9 of claim 19, which recite "wherein, if the mailpiece does not have the code on the front or on the back of the mailpiece, the sorting step includes the substeps of:"

So, for this claim, somewhere between line 7 and 9, not only does this claim comprise merely an ages-old method in the instance a normal, front-code-containing mailpiece is dropped in, but an array of new method steps blooms into existence in the event that any other piece of matter happens to stray into consideration which fails to have a code, and at this crucial moment, all of the preceding method steps are snuffed out of consideration. Truly, the existence of steps is conditional upon the existence of code.

The Examiner has concentrated upon the recitations which are so blatantly conditionally existing that the allegation cannot be refuted. Applicant's own words, for example as shown in claims 9 and 19 via the discussion above, establish the existence of entire segments, and wipe out of existence other segments, of claims through the simple recitation "if".

Art Unit: 3653

The word “if” appears so many times in the claims, that one reading the claims cannot understand what is being claimed or not.

Going back to claim 9, the recitation “a front code sorting component configured to sort the mailpiece using a code on the front of the mailpiece, if there is a code on the front of the mailpiece.”

Applicant alleges that the component exists, whether or not there is a code on the front of the mailpiece. For the present moment, this allegation will be left alone.

The “sorting component” is “configured to sort” the mailpiece, *if* there is a code on the front of the mailpiece. So, what the component is configured to do is premised on the existence of a code on the front of the mailpiece. Thus, if a mailpiece is entered with a code on the front, then the sorting component is “configured to sort” the mailpiece. However, if the mailpiece does not comprise a code on the front, the sorting component is configured to do absolutely nothing. A component configured to do nothing is not a component. Thus, anything that even slightly fits within the scope of “sorting component” can be inferred from this recitation. And, in an apparatus or method for sorting mail, just about *anything* can be interpreted to be a sorting component. Thus, the claims’ meaning hinges upon the location of the code on the mailpiece.

Referring to applicant’s arguments at the bottom of page 2 continuing to the top of page 3 in the arguments. A method step having three steps, wherein two of the steps are not performed, is a method step having one step.

Art Unit: 3653

Referring to the apparatus steps, and the middle paragraph of page 3 of the arguments; as has already been discussed, perhaps the "components" still exist when the mailpiece has the code in an area not pertaining to the component corresponding thereto. However, in the presence and/or absence of the code, which springs the component into action, the component does nothing, and therefor has no utility. A "sorting component" which is "configured to sort"... *if*... "there is a code on the front..." is not necessarily configured to sort *if* there is not a code on the front. Thus, the art has been applied treating the actual mailpieces discussed in the references as part of the apparatuses themselves, the code and its location on the mailpiece being their own elements and very pertinent to the claims at hand.

A simple rationale may help Applicant in understanding the nature of the ambiguities inherent in the word "if" used in claims, wherein the Examiner compares claim 9 to a conventional mail sorting system.

Referring to claim 9; In applying a reference where there is a code on the front of the mailpiece, the Examiner begins with taking as the first piece of evidence the existence of the mailpiece and the positive existence of the code on the front thereof.

Turning to claim 9, he reads "a front code sorting component configured to sort the mailpiece using a code on the front of the mailpiece, if there is a code on the front of the mailpiece." Surely he has witnessed in the reference that there is a code on the front of the mailpiece, therefore he looks for the front code sorting component, and finds one. Is it configured to sort the mailpiece using a code on the front of the mailpiece? Of course it is.

Art Unit: 3653

He then moves on to "an identifying component configured to identify the mailpiece using a code on the back of the mailpiece, if the mailpiece does not have the code on the front of the mailpiece, and if there is a code on the back of the mailpiece." There is no code on the back of the mailpiece mentioned in the reference (the code being on the front, in this example), and therefore, following the claim, the identifying component is not necessarily required to be configured to identify the mailpiece using the code on the back, because there *is no* code on the back. Thus, he looks for an identifying component and finds one. Is it configured to identify the mailpiece using a code on the back? Well, perhaps, but not necessarily. However, since there is no code on the back of the mailpiece in the reference, then the component can't be configured to identify based upon the code on the back, and thus the reference continues to read on the claim, the functional recitations for the identifying component washing to nothing in the wake of the "if" recitation.

Now, the Examiner arrives at lines 7-9 wherein he finds "if the mailpiece does not have the code on the front or on the back of the mailpiece, the identification code system sorting component further includes:" He looks at the reference. There is a code on the front. Thus, the sorting component does not further include any of the subsequent limitations, and the Examiner, or any reader, is off the hook. There is no need to look further, as there is nothing to look for, because there is a code on the front of the mailpiece.

The Examiner has made the art rejections in his best interpretation of what actually exists in the claims, once a reader goes through the myriad mental exercises

Art Unit: 3653

which may or may not produce a finite amount of substance. Is this "if" more important than that "if"? Does this recitation exist? What is this element "configured to do"? The art's relation to the claims will not be further explained at this point, as there is nothing to relate it to. The claims comprise an infinite number of interpretations, and the Office has not the means by which to purport an infinite number of rejections corresponding thereto.

Applicant states that "Wallach and Rosbenbaum..." do not teach... "an identification code system sorting component that includes an identification code applying component, a postal code applying component, and a creating component..." However, these recitations *follow* the crucial recitation, "wherein, if the mailpiece does not have the code on the front or on the back of the mailpiece, the identification code system sorting component further includes:" and therefore do not exist or need to exist in the two named references because there *is a code* on the front or back of the mailpiece of both references.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

Art Unit: 3653


shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel K Schlak whose telephone number is 703-305-0885. The examiner can normally be reached on Mon-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald Walsh can be reached on 703-306 - 4173. The fax phone numbers for the organization where this application or proceeding is assigned are 703-306-4195 for regular communications and 703-306-4195 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308 - 1113.

dks
December 23, 2002


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